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& LIONE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: Robert W. Bossemeyer, Jr. et al.
Appln. No.: 09/407,126
Filed: September 27, 1999
For: Method, System, and Article for Determining an Availability
of a Telecommunication Feature
Attorney Docket No: 8285/314

Examiner: Igor N. Borissov
Art Unit: 3628
Conf. No.: 2323

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL

Sir:

Attached is/are:

- ☒ Check for \$500 to cover Filing Reply Brief; Transmittal Cover Letter (1p. Filed in Dup.); Reply Brief (5pp.); and
☒ Return Receipt Postcard.

Fee calculation:

- ☐ No additional fee is required.
☐ Small Entity.
☐ An extension fee in an amount of \$_____ for a _____-month extension of time under 37 C.F.R. § 1.136(a).
☐ A petition or processing fee in an amount of \$_____ under 37 C.F.R. § 1.17(____).
☐ An additional filing fee has been calculated as shown below:

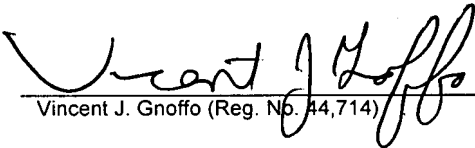
| | | | | | Small Entity | | | Not a Small Entity | |
|---|-------------------------------------|-------|------------------------------------|------------------|--------------|-----------|----|--------------------|-----------|
| | Claims Remaining After Amendment | | Highest No. Previously Paid For | Present Extra | Rate | Add'l Fee | or | Rate | Add'l Fee |
| Total | | Minus | | | x \$25= | | | x \$50= | |
| Indep. | | Minus | | | X100= | | | x \$200= | |
| First Presentation of Multiple Dep. Claim | | | | | + \$180= | | | + \$360= | |
| | | | | | Total | \$ | | Total | \$ |

Fee payment:

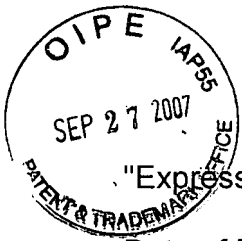
- ☒ A check in the amount of \$500 is enclosed.
☐ Please charge Deposit Account No. 23-1925 in the amount of \$_____. A copy of this Transmittal is enclosed for this purpose.
☐ Payment by credit card in the amount of \$_____ (Form PTO-2038 is attached).
☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925. A copy of this Transmittal is enclosed for this purpose.

Respectfully submitted,

September 27, 2007
Date


Vincent J. Gnoffo (Reg. No. 44,714)

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Date of Deposit: September 27, 2007

PATENT
CASE NO. 8285/314

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|----------------------------------|---|----------------------------|
| In re Application of: |) | |
| |) | |
| Robert W. Bossemeyer, Jr. et al. |) | |
| |) | Examiner: Igor N. Borissov |
| Serial No. 09/407,126 |) | |
| |) | Group Art Unit No. 3628 |
| Filing Date: September 27, 1999 |) | |
| |) | |
| For METHOD, SYSTEM, AND |) | |
| ARTICLE FOR DETERMINING AN |) | |
| AVAILABILITY OF A |) | |
| TELECOMMUNICATION |) | |
| FEATURE |) | |

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

Appellant submits this Reply Brief in response to the Examiner's Answer mailed September 6, 2007. This Reply Brief is filed prior to the end of the two month time window provided under 37 CFR 41.41 and MPEP 1208.

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Reply to Examiner's Answer

The Appellant maintains, as explained in the Appeal Brief filed May 24, 2007, that the claims are patentable over the asserted combinations of Alcott and Mujmudar et al. The Examiner's Answer picks and chooses portions of the cited references to try to come up various aspects of claimed features. Even with such picking and choosing, however, none of the references, alone or in combination, disclose or suggest all of the recited features of the claims. For example, on page 9 of the Examiner's Answer, it is stated that Majmudar et al. was applied to show selecting, by a subscriber, a feature which is not available, upgrading to enable selection of the feature, and displaying the requested new feature. This statement is inaccurate. The system of Majmudar et al. is an arrangement for allowing a subscriber to select from telephone features that are available, not unavailable, to the subscriber. The Examiner's Answer goes on to assert that Alcott discloses missing features of Majmudar et al. of placing a call to inform the first party regarding availability of the feature. This is a misleading and incorrect assertion. Alcott discloses 'an automatic call back feature' *per se*, not automatically calling a subscriber to indicate that a previously unavailable feature has become available to the subscriber. The 'call back' is the feature of Alcott, and it was available to the subscriber. All that is disclosed is that the previously available feature is initiated. In addition, there is no disclosure of a call to the subscriber to have them initiate the feature. See Col. 5, ll. 56-65.

Conversely, claim 1 recites a method to inform a first party of a newly added telecommunication feature to the telecommunication network, where the method places "a call to the first party to inform the first party that the first telecommunication feature has become available, wherein placing the call to inform the first party that the first telecommunication feature has become available occurs before the first party has subscribed to the first telecommunication feature." Claim 1 also recites placing the call to the first party "in response to the inquiring in the first transaction, the upgrading the portion of the telecommunication network, and the processing of the first data structure and the availability data, wherein the first party has the opportunity to subscribe to the first telecommunication feature after the call is placed." Also, "In accordance with upgrading the portion of the telecommunication network which serves the first party,"

availability data is input “which indicates an availability of the first telecommunication feature to the portion of the telecommunication network which serves the first party.” Moreover, “In response to upgrading the portion of the telecommunication network which serves the first party,” the first data structure and the availability data is processed “to determine that the first telecommunication feature has become available to the first party. The references, no matter how they are combined, simply do not disclose or suggest such features.

Further, Appellants maintain that there is not motivation to combine the references. The Examiner’s Answer states that the motivation would be to accommodate needs that subscribers may have and improve customer service. If this were the only motivation that was needed to combine references, it seems that any references could always be combined. The fact remains with regard to these references, that there is no motivation in either of the references to combine the touch screen terminal of Majmudar et al. with the key tone system of Alcott.

B. Claim 9

Claim 9 recites a method where a first party is informed, “in the first call, that the first telecommunication feature is unavailable to the first party.” Second and third calls are also made by second and third parties. The first party, “after the first call, the second call, and the third call have terminated,” is notified “in a fourth call that the first telecommunication feature has become available to the first party by placing a call to the first party.” In addition, notification to the first party “that the first telecommunication feature has become available occurs before the first party has subscribed to the first telecommunication feature.” Moreover, “The placing of the call to the first party occurs in response to the receiving of the first call, the second call and the third call, the upgrading the portion of the telecommunication network, and the processing of the first data structure, the second data structure, the third data structure and the availability data.” “The first party has the opportunity to subscribe to the first telecommunication feature after the fourth call is placed.” As discussed above, neither Alcott nor Majmudar et al., alone or in combination, disclose or suggest at least these features.

C. Claim 10

Claim 10 recites an apparatus with a database “which identifies a first party of a telecommunication network and a first telecommunication feature unavailable to the first party, wherein the first data structure is generated in response to a first inquiry.” A call is placed to the first party, “to inform the first party that the first telecommunication feature has become available occurs before the first party has subscribed to the first telecommunication feature.” In addition, “the placing of the call occurs in response to the first inquiry, the upgrading the portion of the telecommunication network, and the processing of the first data structure and the availability data.” “The first party has the opportunity to subscribe to the first telecommunication feature after the call is placed.” As discussed above, neither Alcott nor Majmudar et al., alone or in combination, disclose or suggest at least these features.

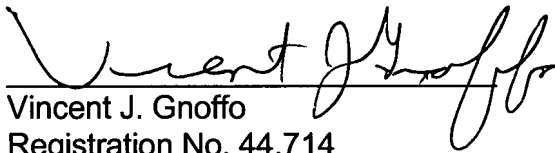
D. Claim 17

Claim 17 recites “a computer-readable medium whose contents cause a computer to store a first data structure which identifies a first party of a telecommunication network and a first telecommunication feature unavailable to the first party.” A call is placed “to inform the first party that the first telecommunication feature has become available occurs before the first party has subscribed to the first telecommunication feature.” “The placing of the call to the first party occurs in response to the storing of the first data structure, the upgrading the portion of the telecommunication network, and the processing of the first data structure and the availability data.” “The first party has the opportunity to subscribe to the first telecommunication feature after the call is placed.” As discussed above, neither Alcott nor Majmudar et al., alone or in combination, disclose or suggest at least these features.

Concluding Remarks

Appellant requests that the Patent Office forward this application to the Board for decision on the appeal upon consideration of the Appeal Brief and Examiner's Answer.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Vincent J. Gnoffo", written over a horizontal line.

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